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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,006	02/01/2001	Thomas Hottkowitz	HUBR1177	6539

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NEW YORK, NY 10103-3198

EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 02/25/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.



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This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire thirty days whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-30 and 32-35 are pending in the application.
- ☐ Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☒ Claim(s) 1-30 and 32-35 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

09/762,006

## DETAILED ACTION

Claims 1-30 and 32-35 are pending in the application.

### *Election/Restrictions*

Applicants' election with traverse of Group XI and the species of compound 372 in Paper No. 9 is acknowledged. The traversal is on the ground(s) that Groups I-XXII should be rejoined since the groups share the same or corresponding special technical features. Applicants allege that the special technical feature is a phospholipid of formula (I) having an apolar portion. Applicants also argue that if the compounds of claim 1 are patentable, the liposomes containing these compounds and compositions should also be patentable.

Applicants' arguments have been considered but have not been found persuasive. The claims lack unity of invention because the claims do not have a common structural feature that defines a contribution over the prior art. A " $\text{PO}_3^-$  group", the special technical feature, is not a significant structural element that defines a contribution over the prior

art. Variables are not considered when ascertaining the special technical feature.

Each of the groups set forth in the previous Office Action represents patentably distinct compounds which one skilled in the art which besides sharing no significant structural element, cannot be said to belong to a recognized class of chemical compounds. Accordingly, the unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Additionally, under Lack of Unity, Applicants are entitled to an examination of only one (e.g. product, process of making, etc.) from each of the categories of invention. Therefore, the liposomes would be not rejoined with products (compounds of Group XI and compositions) if the products of Group XI are allowed.

The requirement is still deemed proper and is therefore made  
FINAL.

Subject matter not embraced by elected Group XI and claims 16-30, 32, 34 and 35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected inventions. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

It is suggested that in order to advance prosecution, the non-elected subject matter be canceled when responding to this Office Action.

*Priority*

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

*Specification*

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 10, 12, 14 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by AT 393505.

AT 393505 disclose the compound of Example 14 on page 18 {CA Registry Number 139257-00-4}, which is embraced by the instant claims, that has cytotoxic activity and is used in antitumor compositions.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over AT 393505 and Eibl et al. {EP 534,445}, each taken alone.

*Determination of the scope and content of the prior art (MPEP §2141.01)*

Applicants claim phosphates and phosphoamines. AT 393505 teaches phosphates and phosphoamines which are either structurally the same (see above 102 rejection) or structurally similar to the instant claimed compounds (see page 9, lines 22-47 and especially Example 14

on page 18). Eibl et al. also teach phosphate esters which are structurally similar to the instant claimed compounds (page 2, lines 25-42 and Example 5 on page 6).

*Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)*

The difference between some of the compounds of the prior art and the compounds instantly claimed is that of generic description.

*Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)*

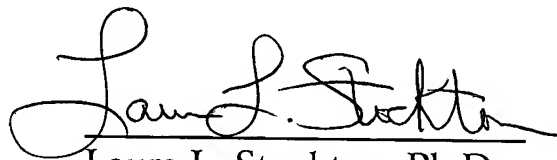
The indiscriminate selection of "some" among "many" is *prima facie* obvious. The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g. cytotoxic activity). One skilled in the art would thus be motivated to prepare compounds embraced by the prior art to arrive at the instant claimed compounds with the expectation of obtaining additional beneficial compounds which would have cytotoxic activity and be used to treat tumors. Therefore, the instant claimed compounds would have been suggested to one skilled in the art.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235, 308-0196 or 305-3290.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556, 308-4242, 305-1935 or 308-2742.

A handwritten signature in cursive script, reading "Laura L. Stockton". The signature is written in dark ink and is positioned above the printed name and title.

Laura L. Stockton, Ph.D.  
Patent Examiner  
Art Unit 1626, Group 1620  
Technology Center 1600

July 10, 2002